UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,432	03/08/1999	PHILLIP Y. GOLDMAN	14531.46	3073

22913 7590 03/01/2004

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY)
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	25

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/264,432	GOLDMAN ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,5,7,8,14,15,19,33-42 and 44-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5,7,8,14,15,19,33-42,44 and 46-48* is/are rejected.

7)☒ Claim(s) *45* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 34, and 44 have been considered but are moot in view of the new ground(s) of rejection.

With respect to the previous ground of rejection of Perlman et al., in view of Ballard, and in further view of Eldering et al., the applicant arguments were persuasive respect to the combined references not disclosing or suggesting the limitation pertaining to the "insertion" of the selected advertisement being conducted "prior to" the display of the "information document".

2. Applicant's arguments with respect to claims 44 and 46-48 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the

time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 4, 5, 7, 8, 14, 15, 19, 33-42, 44, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al. (US Pat No. 5,887,133), in view of Perlman et al. (WO 98/56128), in view of Ballard (US Pat No. 6,182,050), and in further in view of Eldering et al. (US Pat No. 6,457,010).

In consideration of claims 1 and 34, the Brown et al. reference discloses an "information retrieval system" [10] comprising a "server computer" [24/26/28/34] and a "client system having a display device" [58] wherein the "client system has access to television programming viewed by a user of the information retrieval system" (Col 5, Line 23 – Col 6, Line 4). As illustrated in conjunction with Figure 7, the "client system" [58] "requests an information document from the server computer" and "based at least in part on the profile" "selects, at the client system" a substitute portion for the retrieved document, and "inserts" the data thereby "overwriting a preexisting advertisement that was included within the information document requested from the server" such that the "preexisting advertisement is overwritten in the information document prior to the information document being displayed" (Col 4, Lines 17-21; Col 8, Line 37 – Col 10, Line 58). Accordingly, while the reference discloses many of the claimed elements, the reference does not disclose the claimed limitations pertaining to the usage of a local advertisement repository, the compiling of a profile comprising at least information associated with television programming, and details pertaining to the profile not being shared.

The Brown et al. embodiment, in conjunction with "overwriting a preexisting advertisement that was included within the information document requested from the server", downloads information from a substitute document server [34] containing information which is not requested or solicited but is deemed desirable or useful (Col 5, Line 66 – Col 6, Line 2). The Perlman et al. reference discloses a method for providing desirable information during off-peak hours as selected by editorial staff based either on payments or consideration that the items are novel or of general interest (Page 12, Lines 5-21). These advertisements are subsequently inserted from the "advertisement repository being stored at the client system" [220] into the retrieved "information documents" and "displayed" [105] (Page 13, Lines 22-28). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Brown et al. embodiment so as to utilize a local repository comprising information that may be desirable or useful for insertion into requested information documents as taught by Perlman et al. for the purpose of providing a means by which to deliver high bandwidth content over a low bandwidth communication channel during off peak hours based on criteria of interest (Perlman et al.: Page 2, Lines 21-25).

The aforementioned combined references however, do not explicitly disclose, nor preclude, that the embodiment is operable to "compile a user profile at the client system". The Ballard reference discloses an embodiment wherein an "information retrieval system" [14] (Col 5, Lines 41-45, 54-64) may "insert data representing the selected advertisement" based on a "profile of the user of the information retrieval system at the client system" (Col 7, Lines 50-65) which is not "sent to the server computer" [52] for purposes of selecting advertisements or other information that is desirable or useful to be inserted into information

documents which are sent via the server (Col 12, Lines 30-67 – Col 13, Lines 1-41). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined references, if necessary, to "compile a profile of the user of the information system" as taught by Ballard for the purpose of selecting the most relevant advertisements from the "repository" in a manner that further protects consumer privacy (Ballard: Col 1, Lines 7-60). The ability to protect consumer privacy would be particularly advantageous presuming the profile contains information related to the user's medical history as suggested in Brown et al.

The combined references, however, do not explicitly disclose, nor preclude that the "profile includes at least information associated with television programming". The Ballard reference suggests that the "profile" may monitor "usage" (Col 7, Lines 21-25). Furthermore, the Brown et al. embodiment utilizes a profile that includes user preferences, past activity data or even medical records (Col 10, Lines 19-22). The Eldering et al. reference discloses a method for advantageously characterizing a subscriber of an "information retrieval system", such as a PC-TV device, (Col 7, lines 1-12) with information that is "stored locally" (Col 6, Lines 66-67 – Col 7, Line 1) and does not necessarily need to be shared (Col 2, Lines 55-67 – Col 3, Lines 1-4). The developed profile may be based "at least information associated with the television programming viewed by the user" (Col 5, Lines 25-35). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the "profile" of the combined references, if necessary, with information pertaining to the "television programming viewed by the user" when using a PC-TV as taught by Eldering et al. Such a modification would advantageously enhance the

ability to identify information that is desirable or useful in a manner that further preserves privacy by using both viewing and demographic information to provides additional dimensions when targeting advertisements or other information of interest (Eldering et al.: Col 2, Lines 8-11).

Claims 4 and 35 are rejected wherein the "act of inserting data representing the selected advertisement is conducted at the client system" (Brown et al.: Col 10, Lines 49-58; Perlman et al.: Page 18, Lines 11-20; Ballard: Col 13, Lines 4-25).

Claims 5 and 36 are rejected wherein the Perlman et al. reference teaches that information such as advertisements may be "pre-downloaded" and stored in memory on the client system (Page 12, Lines 15-26; Page 18, Lines 11-20; Figure 5).

Claims 7 and 37 are rejected wherein the "information document" is a web page in HTML format (Brown et al.: Col 6, Lines 44-52).

Claims 8 and 38 are rejected aforementioned wherein the "profile" may be constructed "to further characterize the user" using a combination of user supplied demographic data, and tracking information as illustrated in Figure 1 of the Eldering et al. reference.

In reference to claims 14-15 and 39-40, the Perlman et al. reference discloses that the host server may provide supplemental information including "news" [308] and "reference information related to the content of the television programming" such as sports information provided on ESPN® (Page 11, Lines 24-31 – Page 12, Lines 1-2).

Claims 19 and 41 are met wherein the Perlman et al. reference discloses that information may be "pushed" to the client during off-peak periods (Figure 5; Page 12, Lines 18-21; Page

20, Lines 14-30). It is well known in the art that "push" technology does not require "direct user assistance".

Claims 33 and 42 are rejected wherein the compiling of a "profile includes an act of identifying closed captioning received from television programming" (Eldering et al.: Col 5, Lines 36-46).

6. Claims 44 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128), in view of Ballard (US Pat No. 6,182,050), and in further in view of Eldering et al. (US Pat No. 6,457,010).

In consideration of claims 44 and 48, the Perlman et al. reference shows the schematic structure of a communications network for use with a "computer program product having one or more computer-readable media having computer-executable instructions" for implementing a "information retrieval system" such as the WebTV© client terminal [180] (Figure 1B). The client terminal [180] facilitates shared screen viewing of television/internet content. Subsequently, it handles both the "request" for and "display" of "information documents" or HTML web pages (Page 5, Lines 9-19). The Perlman et al. reference teaches that the embodiment is operable to deliver potentially relevant material during off-peak hours as selected by editorial staff based either on payments or consideration that the items are novel or of general interest (Page 12, Lines 5-21). These advertisements are subsequently inserted from the "advertisement repository being stored at the client system" [220] into the retrieved "information documents" and "displayed" [105] (Page 13, Lines 22-28).

The aforementioned Perlman et al. reference, however, does not explicitly disclose, nor preclude, that that the embodiment is operable to "compile a user profile at the client system .

. . ". The Ballard reference discloses an embodiment wherein an "information retrieval system" [14] (Col 5, Lines 41-45, 54-64) may "insert data representing the selected advertisement" based on a "profile of the user of the information retrieval system at the client system" (Col 7, Lines 50-65) which is not "sent to the server computer" [52] for purposes of selecting advertisements to be inserted into information documents which are sent via the server (Col 12, Lines 30-67 – Col 13, Lines 1-41). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Perlman et al. reference, if necessary, to "compile a profile of the user of the information system" as taught by Ballard for the purpose of selecting the most relevant advertisements from the Perlman et al. "repository" [220] in a manner that further protects consumer privacy (Ballard: Col 1, Lines 7-60).

The combined Perlman et al. and Ballard references, however, do not explicitly disclose, nor preclude that the "profile includes at least information associated with . . . television programming". The Ballard reference suggests that the "profile" may monitor "usage" (Col 7, Lines 21-25) which in light of the combined references is construed as including television programming. The Eldering et al. reference discloses a method for characterizing a subscriber of an "information retrieval system", such as a PC-TV device, (Col 7, lines 1-12) with information that is "stored locally" (Col 6, Lines 66-67 – Col 7, Line 1) and does not necessarily need to be shared (Col 2, Lines 55-67 – Col 3, Lines 1-4). The developed profile may be based "at least information associated with both more recently viewed television programming and less recently viewed television programming" (Col 5, Lines 25-35). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the "profile" of the combined Ballard and Perlman et al. references, if necessary, with information pertaining to the "television programming viewed by the user" when using a PC-TV as taught by Eldering et al. Such a modification would advantageously enhance the advertisement affinity ranking of Ballard since a "profile" that characterizes a viewer using both viewing and demographic information, subsequently provides additional dimensions to use when targeting advertisements (Eldering et al.: Col 2, Lines 8-11).

In developing the "profile", the Eldering et al. reference, however, does not explicitly disclose, nor preclude that the "more recently viewed television programming [is] given more weight in the profile than the less recently viewed television programming". It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the aforementioned combined reference such that the more recently viewed television programming associated with recent sessions is given more weight in conjunction with the development the weighted average session (Col 12, Line 52 – Col 13, Line 20) since it was known in the art to time decay transactions in conjunction with the development of profiles (ex. Kramer et al.: Col 26, Line 45-52). Such a modification would advantageously provide a means for reflecting that transactions that occurred long in the past have less relevance in determining today's preferences, hence providing a means for capturing/reflecting a viewer's changing preferences over time.

Claim 46 is rejected wherein the Perlman et al. reference suggests that the "inserted data" or advertisements may replace a "preexisting advertisement that was included within the information document requested form the server" (Page 18, Lines 11-20).

Claim 47 is rejected wherein the "selected advertisement is selected prior to requesting the information document" wherein the Ballard reference suggests that the user is sent advertisement target criteria and "prior to requesting the information document" the "client system" selects which of these advertisements are to be "stored" in the "advertisement repository at the client system" and subsequently inserted/displayed (Col 12, Lines 41-64).

7. Claims 44 and 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlman et al. (WO 98/56128, in view of Bedard (US Pat No. 5,801,747), and in further view of Ballard (US Pat No. 6,182,050).

In consideration of claims 44 and 48, the Perlman et al. reference shows the schematic structure of a communications network for use with a "computer program product having one or more computer-readable media having computer-executable instructions" for implementing a "information retrieval system" such as the WebTV© client terminal [180] (Figure 1B). The client terminal [180] facilitates shared screen viewing of television/internet content. Subsequently, it handles both the "request" for and "display" of "information documents" or HTML web pages (Page 5, Lines 9-19). The Perlman et al. reference teaches that the embodiment is operable to deliver potentially relevant material during off-peak hours as selected by editorial staff based either on payments or consideration that the items are novel or of general interest (Page 12, Lines 5-21). These advertisements are subsequently inserted from the "advertisement repository being stored at the client system" [220] into the retrieved "information documents" and "displayed" [105] (Page 13, Lines 22-28).

The aforementioned Perlman et al. reference, however, does not explicitly disclose, nor preclude, that that the embodiment is operable to "compile a user profile at the client system .

. . ". The Bedard reference discloses a PC-TV that is operable to "compile a profile of the user" including "at least information associated with both more recently viewed television programming and less recently viewed television programming, with the more recently viewed television programming being given more weight in the profile than the less recently viewed television programming" (Col 5, Line 34 – Col 7, Line 5). Such a profile may be shared with broadcasters to target commercials or may be utilized in retrieving information of interest via the Internet (Col 8, Lines 16-21, 31-63). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Perlman et al. so as to utilize the profile generation of Bedard for the purpose of identifying and proving information of interest from the internet based upon a viewer's past television viewing behavior (Bedard: Col 1, Line 67 – Col 2, Line 3).

The combined references, however, do not explicitly disclose nor preclude that the "profile is stored at the client system without being set to the server for the purposes of selecting advertisements". Rather, in light of the combined references, it is more likely that profile information is shared for the selection of advertisements. However, the Ballard reference discloses a method for allowing targeted advertisements that further protects a user's concerns for privacy. The Ballard "information retrieval system" [14] (Col 5, Lines 41-45, 54-64) may "insert data representing the selected advertisement" based on a "profile of the user of the information retrieval system at the client system" (Col 7, Lines 50-65) which is not "sent to the server computer" [52] for purposes of selecting advertisements to be inserted into information documents which are sent via the server (Col 12, Lines 30-67 – Col 13, Lines 1-41). The compiled profile may further be based on monitored "usage" (Col 7,

Lines 21-25). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined teachings, if necessary, to "compile a profile of the user of the information system" as taught by Ballard for the purpose of selecting the most relevant advertisements from the Perlman et al. "repository" [220] based on the locally based user profile in a manner that advantageously protects consumer privacy (Ballard: Col 1, Lines 7-60).

Claim 46 is rejected wherein the Perlman et al. reference suggests that the "inserted data" or advertisements may replace a "preexisting advertisement that was included within the information document requested form the server" (Page 18, Lines 11-20).

Claim 47 is rejected wherein the "selected advertisement is selected prior to requesting the information document" wherein the Ballard reference suggests that the user is sent advertisement target criteria and "prior to requesting the information document" the "client system" selects which of these advertisements are to be "stored" in the "advertisement repository at the client system" and subsequently inserted/displayed (Col 12, Lines 41-64).

Allowable Subject Matter

8. Claim 45 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In particular, there is no suggestion in the combined art of record such that the "most recently viewed television program is solely used to select the advertisement". The previous grounds of rejection were based on the premise that only one program was viewed during the session. However, the examiner's interpretation of claim 44

is such that it now requires the viewing of multiple programs namely a "newer" and an "older" program.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Alexander et al. (US Pat No. 6,177,931) reference discloses a method for targeting advertisements within an EPG using a profile compiled by monitoring of a user's internet and television interactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access

to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
February 23, 2004

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600